

REMARKS

Claims 1-28 are pending in the application after this amendment. The amendment and/or addition of claims is not to be considered in any way an indication of applicants' position on the merits of the amended and/or added claims. In the following sections of the Amendment, the rejections set forth by the Examiner in the September 9, 2005 Office action are addressed. These rejections are respectfully traversed, and detailed arguments are set forth below.

The Examiner rejected claims 1-18 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicants regard as the invention. More specifically, the Examiner directs attention to the claim language of "a cease and desist module is capable of attempting to remove the infringing content" and of "attempting to remove." The Examiner states that it "is unclear what the applicants mean by 'attempting to remove' and what is making the attempt." Claim 1 does not include a step of attempting to remove. Accordingly, applicants request that this rejection should be removed as it pertains to claim 1 and the claims that depend from claim 1. Applicants have amended claims 9, 12, 15, and 18 to clarify that the infringing content is removed from the communication medium service having potentially infringing content. Applicants respectfully submit that from the ordinary and customary meaning of the terms rejected by the Examiner would be clear to one skilled in the art. Further, applicants respectfully submit that the specification would provide sufficient support such that the meaning of the terms rejected by the Examiner would be clear. Applicants have added new claims 19-23 that specifically claim alternative embodiments of attempting to stop infringements or attempting to remove infringing content. These new claims are supported in the specification and no new matter has been added.

The Examiner rejected claims 15-17 under 35 USC Sec. 101 as being directed to non-statutory subject matter. The Examiner appears to be using a "technological arts" test. Applicants specifically submit that the "technological arts" test was specifically rejected in precedential opinion *Ex parte Carl A. Lundgren*, Appeal No.

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2003-2088 (Bd. Pat. App. & Interf. 2005) stating "Our determination is that there is currently no judicially recognized separate "technological arts" test to determine patent eligible subject matter under § 101. We decline to propose to create one." Further, the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility specifically states that "USPTO personnel should no longer rely on the technological arts test to determine whether a claimed invention is directed to statutory subject matter." Applicants have amended claim 15 to clarify the invention, but reserve the right to file continuation applications directed to the original claim. Applicants respectfully submit that claim 15 and the claims dependent thereon are directed to patentable subject matter.

The Examiner has rejected the claims under 35 USC Sec. 103 as "obvious" in view of U.S. Patent No. 6,289,341 to Barney (the "Barney reference") in combination with U.S. Patent No. 6,401,118 to Thomas (the "Thomas reference").

Applicants respectfully submit that the claimed invention is not obvious over a combination of the Barney reference and the Thomas reference. In fact, even if the Examiner finds every element of the claimed invention in the prior art (which applicants are not admitting the Examiner has done), it is not sufficient to negate patentability as it only shows that the Examiner is using the claimed invention itself as a blueprint for piecing together elements in the prior art. The general rule relating to the obviousness of an invention that combines old elements is the same as that for inventions that include all new elements, i.e. whether it would have been obvious to have combined the claimed elements on the basis of the prior art. The Federal Circuit has held that when the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination. No such suggestion or motivation has been provided. Applicants respectfully submit that merely stating that it would have been obvious for one of ordinary skill in the art to combine the teachings for enforcement purposes is not sufficient. Applicants respectfully request clarification of this rejection if it is to be maintained.

Applicants have chosen not to present arguments specific to each of the pending claims, but reserve the right to present such arguments in future communications. Applicants would, however, like to address a few of the original dependent claims which are clearly not anticipated by or obvious over the Barney reference and/or the Thomas reference alone or in combination.

Claims 3, 11, 14, and 17 all address the idea of interfacing a plurality of service or scanning modules "to provide a communication link to a possible infractor." This claimed feature is not taught or suggested in the Barney reference or the Thomas reference. The Examiner's rejections of these claims appears to be based on Figure 1 of the Barney reference or the text of the Barney reference at column 2, line 62 through column 4, line 30. Even assuming that these portions of the Barney reference show service modules interfacing with each other, which applicants specifically do not admit, they do not show at least one service module passing a communication link to a possible infractor to another service module. This claimed feature is discussed in applicants' original specification, for example, beginning at page 7, line 29:

"The Usenet module 130 may perform cross-service referrals by passing links referring to other communication services to their respective service modules for follow-up processing. For example, FTP advertisements may be sent to the FTP module 140, WWW advertisements may be sent to the WWW module 160, and IRC channels may be sent to the IRC module 150. It should be noted that the Usenet module 130 may receive links from the other service modules."

Applicants respectfully submit that because at least one claimed element is not taught or suggested by either of the cited references, that claims 3, 11, 14, and 17 are allowable. Applicants respectfully request specific citations to the location(s) that this subject matter can be found in the prior art if these rejections are to be maintained.

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New claims 24-28 have been added. These claims are specify that a first service module reviews content of a first communication medium service for links to a possible infractor on the second communication medium service. These claims further specify that the first service module provides a communication link to the second service module for follow-up processing. The disclosure of the subject matter of claims 24-28 can be found, for example, beginning at page 7, line 8 of the original specification. This subject matter is not anticipated by or obvious over the Barney reference and/or the Thomas reference alone or in combination.

Finally, please note that there are errors in the published application (US 2001/0041989) that are not present in the originally submitted document. For example, in paragraph 0036 the term "high-volume" has been erroneously changed to "highvolume". Another example is that in claim 2, the introductory parenthesis has been omitted from subsection (r). Applicants respectfully request that these errors and other errors that were introduced in the published application be corrected in any patent resulting from the present invention.

Reconsideration of the claims is respectfully requested in view of the above amendments and remarks, and early notice of allowance thereof is earnestly solicited.

A Petition for Extension of Time for Three (3) Months is enclosed herewith.

Please charge Deposit Account No. 50-2115 for any additional fees that may be required.

Respectfully submitted,



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